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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,058	11/26/2003	Michael Roberts	NECW 20.768	8639

26304 7590 08/11/2005

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575 MADISON AVENUE  
NEW YORK, NY 10022-2585

EXAMINER
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FIGUEROA, MARISOL

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/723,058

Applicant(s)

ROBERTS, MICHAEL

Examiner

Marisol Figueroa

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

2. **Claim 2** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

**Regarding claim 2**, the phrase “circuit switching (CS) type” renders the claims indefinite because the addition of the word “type” to an otherwise definite expression (e.g., circuit switching network or connection) extends the scope of the expression so as to render it indefinite (*Ex parte Copenhagen*, 109 USPQ 118 (Bd. App. 1955)). See MPEP § 2173.05(b).

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-5** are rejected under 35 U.S.C. 102(e) as being anticipated by **Laitinen et al. U.S.**

**Publication No. 2003/0189912 A1.**

**Regarding claim 1**, Laitinen discloses a method of handover in a multimode mobile telecommunication network (P.0005, lines 1-6) in which, to initiate a handover, the network sends to

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a mobile terminal a first group of system information via a first channel associated with circuit switching services and a second group of system information via a second channel associated with packet switching services (P.0025; a dual-mode MS receives information of 3G neighbor Cell list in a SI2quarter message from the BCCH channel and a PSI3quarter message on the PBCCH channel), comprising the steps of:

a) performing measurements at least in one neighboring cell on a basis of information contained in the second group of system information (P.0026, P.0058, lines 1-10; the mobile station receives information from the network over the PBCCH and construct a Neighbor Cell list and measures the cells contained in the list);

b) sending to the network the measurements performed in step a) (P.0058, lines 1-10; the MS reports the measurements to the network), and

c) initiating the procedure of handover according to the measurements performed in step a) (P.0005, lines 1-6; P.0019; the wireless network commands to the MS to perform handover if necessary).

**Regarding claim 2**, Laitinen discloses the method according to claim 1, wherein the measurements are performed in a neighboring cell of circuit switching (CS) type (P.0005, lines 1-6; UMTS cells).

**Regarding claim 3**, Laitinen discloses the method according to claim 2, wherein the telecommunication network is a GSM/GPRS network (P.0019; it is inherent to recognize that the telecommunication network could be a GSM/GPRS network since the MS is dual mode GSM/UMTS and compatible with network), and wherein the first channel is a BCCH channel and the second channel is a PBCCH channel (P.0025; the MS receives a SI2quarter message from a BCCH channel and a PSI3quarter message from a PBCCH channel).

**Regarding claim 4**, Laitinen discloses the method according to claim 2, wherein the telecommunication network is a UMTS network (P.0019, lines 1-3; it is inherent to recognize that the telecommunication network is also a UMTS network because the MS station is a dual mode terminal compatible with a multimode network, i.e. GSM, GPRS, and UMTS).

**Regarding claim 5**, Laitinen discloses a mobile terminal used in a multimode mobile telecommunication network (P.0019, lines 1-3), the mobile terminal performing measurements for preparing for a handover in the network, the measurements depending either on a first group of system information sent by the network to the mobile terminal via a circuit switching channel or on a second group of system information sent by the network to the mobile terminal via a packet switching channel, the mobile terminal comprising:

means for performing measurements at least in one neighboring cell on a basis of information contained in the second group of system information, means for sending to the network the measurements performed (P.0058, lines 1-10; is inherent to recognize that the mobile terminal has means for performing measurements of cells and means for sending these measurements to the network since it performs these procedures), and

means for initiating the procedure of handover according to the measurements performed (P.0005, lines 1-6; the MS measures and send the reports of measurements to the network and this enables the network to command a handover if it is determine from the measurements that a handover is necessary).

#### ***Prior Art of Record***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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(a) **Lyer et al.** (US 6,295,450 B1): Method and Apparatus for Transferring Communication within a Communication System

(b) **Cao et al.** (US 2003/0195003 A1): Method for Informing Mobile User Terminals Camped on a Cell of a Base Station that a Service is Unavailable

***Conclusion***

Any response to this Office Action should be **faxed to (703) 872-9306 or mailed to:**

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P.O. Box 1450  
Alexandria, VA 22313-1450

**Hand-delivered responses** should be brought to

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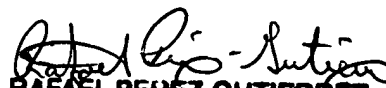
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marisol Figueroa whose telephone number is (571) 272-7840. The examiner can normally be reached on Monday Thru Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have

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questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Marisol Figueroa

  
RAFAEL PEREZ-GUTIERREZ  
PATENT EXAMINER  
8/5/05